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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,305	04/10/2001	Robert A. Kronenberger	130.00095	2960

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10/28/2005

WOOD, PHILLIPS, VAN SANTEN, CLARK & MORTIMER
SUITE 3800
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CHICAGO, IL 60661

EXAMINER

SMITH, JEFFREY A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,305

Applicant(s)

KRONENBERGER, ROBERT A.

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10, 14-20 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10, 14-20 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

The response filed August 1, 2005 has been entered and considered.

Claims 1, 2, 11-13, 21, and 22 have been cancelled.

Claims 3-10, 14-20, and 23-25 are pending.

Claims 14-16, 18, and 19 are currently amended.

An action on the merits follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 4, 6-8, 10, 19, 20, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin (US 2005/0131571 A1) in view of Berger et al. (U.S. Patent No. 6,414,693 B1).

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Costin discloses a method for facilitating sale to a potential customer of an object (par. 0030) over a computer network (par. 0028), said object having a predetermined three-dimensional shape.

The method comprises, over the computer network, providing the potential customer with a display with a plurality of display icons (see Fig. 3; and par. 0033) representing different views (see par. 0033, last two lines) of a predetermined three-dimensional shape of one object (par. 0033);

over the computer network, providing the potential customer with a user input for a design element selected by the user to be included on said object (par. 0036);

providing an input for said user to select any of said plurality of display icons (par. 0034); and

over the computer network, providing the potential customer with views of the user selected design element on the object represented by the selected display icon, wherein said user inputs are adapted to provide different views of said object with said display element displayed thereon as selected (par. 0043).

Costin discloses that the display icons represent a plurality of different objects (see Fig. 3: "HARD JEANS, CARPENTER JEANS, WIDE LEG, BAGGY, LOOSE, RELAXED, REGULAR, BOOT

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CUT"; and teaching at par. 0033 that "[t]he picture that is provided corresponds generally to the selection"), including a plurality of different views for each object (see Fig. 3).

Costin discloses that the design element is user created text (par. 0052).

Costin discloses that the design element may be selected from among a plurality of design elements, where user selected text may be included in at least one of said plurality of design elements (par. 0052-0053: note that the design element comprises the user selected text as well as user selected font(s) and point(s)).

Costin discloses providing a user input for selecting among different portions of the object for placement of the design element (par. 0034).

Costin discloses providing a user input for ordering the object with the user selected design element and receiving a user order from said user input for ordering the object with the user selected design element (par. 0048).

Costin does not describe the views other than to say that "[t]he receiving computer provides the diagram shown in Fig. 5, which shows the front and back of the apparel on the screen" (par. 0033). Nonetheless, Costin is clear that the purpose of providing views is to allow the user to select areas on the

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views which represent the actual placement of user selected designs on the actual object. Such views permit a user to decide if he/she likes the look of the object thus modified and is thus satisfied (par. 0055).

Berger et al., in a similar method (col. 1, line 65-col. 2, line 28), discloses an icon representing a perspective view of a predetermined three-dimensional shape of one object (see Figs. 7-9).

It would have been obvious to one of ordinary skill in the art to have modified the views of Costin to have included, specifically, perspective views (as of the type taught by Berger et al.) in order to have assisted potential customers in coming to a final determination on a customized design as the perspective views would have shown the finished object in a relatively accurate way. Such perspective views would have provided more information about the finished object to the potential customer--thereby eliminating "mistakes" that would have resulted had less information about the finished object been provided to the potential customer (see Berger et al.: col. 8, lines 20-29).

Regarding claims 19-23, and 25: See client/server arrangement in Fig. 1 and described at paragraphs 0026-0029.

Claims 5, 9, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin (US 2005/0131571 A1) and Berger et al. (U.S. Patent No. 6,414,693 B1) as applied to claims 3, 8, and 19, respectively, above, and further in view of Knight (U.S. Patent No. 6,344,853 B1).

Costin teaches facilitating the sale of garment or apparel objects. Costin, for example, teaches that his system and method can accommodate "literally every possibility of apparel that can be made at the manufacture's processing location" (par. 0029). Specifically, Costin discloses "jeans, shorts, shirts, jackets" (par. 0030).

Costin, however does not disclose facilitating the sale of a cap.

Now comes Knight. Knight teaches a method and system for facilitating the sale of a cap (col. 1, lines 7-22; and Figs. 3D-3F). Such cap is shown to include a crown and a visor (best seen in Fig. 3D).

It would have been obvious to one of ordinary skill in the art to have provided the combination of Costin and Berger et al. to have included the specification of a cap having a crown and a visor. Such cap would have represented one of the "literally every possibility of apparel" taught by Costin. Moreover, such cap is specifically taught by Knight as being a particular type

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of apparel both suitable and desirable for implementation in a method of the type disclosed by Costin (as modified by Berger et al.). See Knight at col. 1, lines 7-22.

Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin (US 2005/0131571 A1) in view of Berger et al. (U.S. Patent No. 6,414,693 B1) and Knight (U.S. Patent No. 6,344,853 B1).

Costin discloses a method for facilitating sale of an apparel object (par. 0030) over the Internet (par. 0028).

The method comprises, over the Internet, providing a user input for selecting at least one display icon from a plurality of display icons (see Fig. 3; and par. 0033), each of said display icons representing different views (see par. 0033, last two lines) of one apparel design offered for sale (par. 0033; and pars. 0047-0048);

over the Internet, providing a user input for a design element to be included on said apparel object (par. 0036); and

over the Internet, providing a display illustrating the cap represented by the selected display icon with the user created text at the user selected location on said apparel object (par. 0043).

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Costin discloses that the design element is user created text (par. 0052).

Costin discloses that the design element may be selected from among a plurality of design elements, where user selected text may be included in at least one of said plurality of design elements (par. 0052-0053: note that the design element comprises the user selected text as well as user selected font(s) and point(s)).

Costin discloses providing a user input for selecting among different portions of the apparel object for placement of the design element (par. 0034).

Costin discloses providing a user input for ordering the apparel object with the user selected design element and receiving a user order from said user input for ordering the apparel object with the user selected design element (par. 0048).

Costin does not describe the views other than to say that "[t]he receiving computer provides the diagram shown in Fig. 5, which shows the front and back of the apparel on the screen" (par. 0033). Nonetheless, Costin is clear that the purpose of providing views is to allow the user to select areas on the views which represent the actual placement of user selected designs on the actual apparel object. Such views permit a user

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to decide if he/she likes the look of the object thus modified and is thus satisfied (par. 0055).

Berger et al., in a similar method (col. 1, line 65-col. 2, line 28), discloses an icon representing a perspective view of a predetermined three-dimensional shape of one object (see Figs. 7-9).

It would have been obvious to one of ordinary skill in the art to have modified the views of Costin to have included, specifically, perspective views (as of the type taught by Berger et al.) in order to have assisted users in coming to a final determination on a customized design as the perspective views would have shown the finished object in a relatively accurate way. Such perspective views would have provided more information about the finished object to the user--thereby eliminating "mistakes" that would have resulted had less information about the finished object been provided to the user (see Berger et al.: col. 8, lines 20-29).

The combination of Costin and Berger et al. is yet to provide that the apparel is a cap. Costin, however, and as noted above, teaches facilitating the sale of apparel objects. Costin, for example, teaches that his system and method can accommodate "literally every possibility of apparel that can be made at the manufacture's processing location" (par. 0029).

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Specifically, Costin discloses "jeans, shorts, shirts, jackets" (par. 0030).

Now comes Knight. Knight teaches a method and system for facilitating the sale of a cap (col. 1, lines 7-22; and Figs. 3D-3F). Such cap is shown to include a crown and a visor (best seen in Fig. 3D).

It would have been obvious to one of ordinary skill in the art to have further provided the combination of Costin and Berger et al. to have further included the specification of a cap having a crown and a visor. Such cap would have represented one of the "literally every possibility of apparel" taught by Costin. Moreover, such cap is specifically taught by Knight as being a particular type of apparel both suitable and desirable for implementation in a method of the type disclosed by Costin (as modified by Berger et al.). See Knight at col. 1, lines 7-22.

Response to Arguments

Applicant's arguments filed August 1, 2005 have been fully considered but they are not persuasive.

Applicant remarks that "[converting an item such as jeans, which obviously exists in three-dimensional space when worn, so

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as to display it in what is essentially only a two dimensional manner, will not give the observer any accurate representation of what the jeans (and particularly any added design on the jeans) will actually look like when worn"; "a straight-on view of a design on the front of a pant leg...will not provide any feedback for how the front design may look from the side"; and "[t]he Costin structure will provide a user with no confidence that the design will look good from more than just the straight-on view". Applicant further remarks that Berger et al. and Knight are suffer the same deficiencies.

The Examiner first notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Moreover, the Examiner has acknowledged such the differences between the instant claims and the Costin disclosure. To this end, the Examiner has stated:

"Costin does not describe the views other than to say that '[t]he receiving computer provides the diagram shown in Fig. 5, which shows the front and back of the apparel on the screen' (par. 0033).

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By this admission, the Examiner has acknowledged that Costin does not clearly present the disclosed item (in this case, jeans) in the manner that Applicant presents the item.

The Examiner relies upon the purpose of providing views in Costin in order to establish a logical segue that the skilled artisan would have contemplated in consideration of modification of the Costin invention. That is, the Examiner has stated:

"Costin is clear that the purpose of providing views is to allow the user to select areas on the views which represent the actual placement of user selected designs on the actual object. Such views permit a user to decide if he/she likes the look of the object thus modified and is thus satisfied (par. 0055).".

The Examiner then turns to Berger et al. for its teaching (in an analogous environment) of providing perspective views, rather than the two-dimensional views disclosed by Costin. As such, the Examiner has stated:

"Berger et al., in a similar method (col. 1, line 65-col. 2, line 28), discloses an icon representing a perspective view of a predetermined three-dimensional shape of one object (see Figs. 7-9).

The Examiner then concludes, based upon the claims as a whole and in view of the prior art when taken together for what they collectively teach:

"It would have been obvious to one of ordinary skill in the art to have modified the views of Costin to have included, specifically, perspective views (as of the type taught by

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Berger et al.) in order to have assisted potential customers in coming to a final determination on a customized design as the perspective views would have shown the finished object in a relatively accurate way. Such perspective views would have provided more information about the finished object to the potential customer-- thereby eliminating 'mistakes' that would have resulted had less information about the finished object been provided to the potential customer (see Berger et al.: col. 8, lines 20-29).".

The Examiner has not relied upon any single teaching taken alone. The Examiner has relied upon various combinations of the prior art (as reported above) in order to reach the conclusion that the skilled artisan would have found the invention, as recited in the claims, to have been obvious. This is because the skilled artisan would have recognized that "mistakes" in production of the finished item are greatly reduced, if not "eliminated" (as stated by Berger et al.), when more information about the finished item (or "object" in Berger et al.) is presented to potential customers.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS

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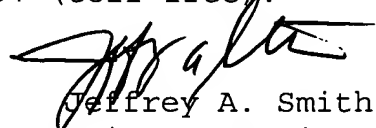
of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Smith
Primary Examiner
Art Unit 3625

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